



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,872	10/28/2003	Nigel J. Renton	03-6171	4103
63710 7590 04/28/2010 INNOVATION DIVISION CANTOR FITZGERALD, L.P. 110 EAST 59TH STREET (6TH FLOOR) NEW YORK, NY 10022				
EXAMINER KANG, IRINE S				
ART UNIT 3695		PAPER NUMBER		
MAIL DATE 04/28/2010		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/694,872

**Applicant(s)**

RENTON ET AL.

**Examiner**

IRENE KANG

**Art Unit**

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/19/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7,9-21,25-35,37-44,47,49-55,57-71,73-83,85-92,95,97-101,105,106,108,109,112,113, and 118-127 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1-7,9-21,25-35,37-44,47,49-55,57-71,73-83,85-92,95,97-101,105,106,108,109,112,113 and 118-127.

### **DETAILED ACTION**

The following is a Non-Final Office Action in response to communications received October 19, 2009. Claims 1, 4, 6, 11, 19, 20, 25-30, 32-35, 37-44, 47, 49, 52, 54, 55, 59, 67, 68, 73, 75-78, 80-83, 85-92, 95, 97, 108, 109, 112, 113, and 118-123 have been amended. Claims 8, 22-24, 36, 45, 46, 48, 56, 72, 84, 93, 94, 96, 102-104, 107, 110, 111, and 114-117 have been cancelled. Claims 105, 106, 108, 109, 112, and 113 have been withdrawn from consideration (see below). New Claims 124-127 have been added. Claims 1-7, 9-21, 25-35, 37-44, 47, 49-55, 57-71, 73-83, 85-92, 95, 97-101, and 118-127 remain pending and considered.

### ***Response to Arguments***

With regards to the bullet points set out on page 37 of Applicant's Arguments made on October 19, 2009, Examiner's response is as follows:

Bullet points 1-3: The Restriction Requirement made on October 2008 was in accordance to operating office policy as of that date, which include the April 25, 2007 memorandum from the Deputy Commissioner for Patent Examination Policy at the time, John Love, and the July 2008, Eighth Edition, Revision 7 version of the MPEP. However, based on current policy and MPEP guidance, applicant's traversal and amendments, and the most recent restriction memorandum given on January 21, 2010 by Robert W. Bahr, Acting Associate Commissioner for Patent Examination Policy, a new restriction is set forth below.

Bullet point 6: Claim 97 is not a generic linking claim according to MPEP §809. A generic claim should be common to every grouping, yet Claim 97 recites changing the bid or offer price which is not required by the other groupings.

***Claim Objections***

**Claim 105** recites the limitation "[t]he method of Claim 104". There is insufficient antecedent basis for this limitation in the claim as Claim 104 is cancelled.

**Claims 106, 108, 109, 112, and 113** recite the limitation "[t]he method of Claim 105". There is insufficient antecedent basis for this limitation in these claims as Claim 105 depends off of Claim 104 which is cancelled.

Applicant is advised that resolution of these issues in a response will advance prosecution.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, 9-19, 32-35, 37-44, 47, 49-55, 57-67, 80-92, 95, 118, 119, 120, 122, and 124-126 drawn to delaying any automatic action toward executing the orders against each other by the electronic trading system until a first timer having a predetermined duration from the receipt of the two orders expires where it is determined that the price of the bid is higher than the price of the offer, classified in class 705, subclass 37.
  - II. Claims 20, 21, 68-71, 121, and 123, drawn to receiving a second order for the first instrument at a second order price, determining that the second order price does not cross or match any existing order, determining that the first order price is lower than the first contra order price and automatically executing a trade between

the second order and the first contra order at the first contra order price, classified in class 705, subclass 37.

- III. Claims 25-31, 73-79, and 127, drawn to starting a timer having a predetermined duration as a result of the second contra order price matching the first order price, and automatically executing a trade between the first and second orders if the first timer expires and both the first and second orders exist at the matched price when the timer expires, classified in class 705, subclass 37.
- IV. Claims 97-101, 105, 106, 108, 109, 112, and 113 drawn to automatically changing at least one of the first bid price and the first offer price as a result of the comparison of the first bid price to the first offer price, classified in class 705, subclass 37.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the determination and execution of the trade of subcombination II has separate utility by itself without the delay of subcombination I as there is no apparent requirement for the delay of subcombination I recited in subcombination II. See MPEP § 806.05(d).
- 3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not

obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the matching of the second order price to the first order price of subcombination III has separate utility by itself without the determining of the price of the bid being higher than the price of the offer of subcombination I as there is no apparent requirement for the determining of the price of the bid being higher than the price of the offer of subcombination I recited in subcombination III. See MPEP § 806.05(d).

4. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the changing of at least one of the first bid price and the first offer price of subcombination IV has separate utility by itself without the delay of subcombination I as there is no apparent requirement for the delay of subcombination I recited in subcombination IV. See MPEP § 806.05(d).

5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the matching of the second order price to the first order price of subcombination III has separate utility by itself without the receiving of multiple same side orders of subcombination II as there is no apparent requirement for receiving of multiple same side orders of subcombination II recited in subcombination III. See MPEP § 806.05(d).

6. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not

obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the changing of at least one of the first bid price and the first offer price of subcombination IV has separate utility by itself without the receiving of multiple same side orders of subcombination II as there is no apparent requirement for the receiving of multiple same side orders of subcombination II recited in subcombination IV. See MPEP § 806.05(d).

7. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the changing of at least one of the first bid price and the first offer price of subcombination IV has separate utility by itself without the matching and execution of the trade of subcombination III as there is no apparent requirement for the matching and execution of the trade of subcombination III recited in subcombination IV. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.



Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required because at least the following reason(s) apply:

The inventions require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search strategies or search queries). For example, Group I would require different search strategies or search queries for automatically executing an order after a pre-determined time has expired when a bid price is above the threshold of an offer price which are not required by the other groups. Group II would require different search strategies or search queries for receiving multiple orders for a first instrument and determining that no orders cross or match, then determining that the first order price is lower than the first contra order price and automatically executing a trade between the second order and the first contra order at the first contra order price which are not required by the other groups. Group III would require different search strategies or search queries for starting a timer in response to the second order price matching the first order price, and automatically executing a trade between the first and second orders if the first timer expires and both the first and second orders exist at the matched price when the timer expires which are not required by the other groups. And Group IV would require different search strategies or search queries for changing at least one of the first bid price and the first offer price as a result of the comparison of the first bid price to the first offer price which are not required by the other groups.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IRENE KANG whose telephone number is (571)270-3611. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571)272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IRENE KANG/  
Examiner, Art Unit 3695  
4/28/2010

/Charles R. Kyle/  
Supervisory Patent Examiner, Art Unit 3695